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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/836,455	05/09/1997	MALAYA CHATTERJEE	304142000322	6310

25226 7590 07/30/2002  
MORRISON & FOERSTER LLP  
755 PAGE MILL RD  
PALO ALTO, CA 94304-1018

EXAMINER	
RAWLINGS, STEPHEN L	
ART UNIT	PAPER NUMBER
1642	30
DATE MAILED: 07/30/2002	

Please find below and/or attached an Office communication concerning this application or proceeding.



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08/836,455

EXAMINER

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Commissioner of Patents and Trademarks

<i>Interview Summary</i>	Application No.	Applicant(s)	
	08/836,455	CHATTERJEE ET AL.	
	Examiner	Art Unit	
	Stephen L. Rawlings, Ph.D.	1642	

All participants (applicant, applicant's representative, PTO personnel):

- (1) Stephen L. Rawlings, Ph.D. (3) Catherine Polizzi  
(2) Donna Wortman, Ph.D. (4) Jill Jacobson

Date of Interview: 25 July 2002 .

Type: a)  Telephonic b)  Video Conference  
c)  Personal [copy given to: 1)  applicant 2)  applicant's representative]

Exhibit shown or demonstration conducted: d)  Yes e)  No.  
If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: 6-19, 38, 41, 44, 45, 57, and 58-80.

#### **Identification of prior art discussed:**

Agreement with respect to the claims f)  was reached. g)  was not reached. h)  N/A.

**Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet .**

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i)  It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

**Examiner Note:** You must sign this form unless it is an Attachment to a signed Office action.

N. A. C. S. V.

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

#### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  

(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Ms. Polizzi and Ms. Jacobson requested clarification of the objection for lack of compliance with the Sequence Rules; the Examiners explained that there are inconsistencies in the specification and that Applicants are required to resolve these inconsistencies and to provide to assurances that changes made in doing so do not introduce new matter. Ms. Polizzi and Ms. Jacobson stated that hybridomas are not naturally occurring and therefore contended that the nucleic acid molecules of hybridomas are not naturally occurring; but nonetheless to advance prosecution Applicants' representatives stated that Applicants are willing to amend claims 6, 14, 15, 72, and 73 to recite "isolated" before "polynucleotide" as was suggested in the previous Office Action and thereby obviate these grounds of rejection. Ms. Polizzi and Ms. Jacobson stated that the rejection of claims under 35 USC 102(b) should have been obviated by Applicants' submission of various declarations under 37 CFR 1.132, since the Office has accepted these declarations previously as a sufficient basis for withdrawal of prior art rejections of claims in related applications. The Examiners, however, note that the previous Office Action details the reasons that the declarations were not found sufficient to obviate the grounds of rejection under 35 USC 102(b); nevertheless,, since Applicants' representatives have indicated Applicants' willingness to amend the claims to recite "isolated" before "polynucleotide" in claims 6, 14, 15, 72, and 73, as was suggested in the previous Office Action, it is anticipated that Applicants' amendment will obviate these grounds of rejection. With regard to the newly raised ground of rejection of claims 14 and 15 under 35 USC 101, Ms. Polizzi and Ms. Jacobson expressed their disagreement, arguing that the asserted utility of the claimed invention is specific and substantial, since the nucleic acid molecules could be used as a probe to determine expression of the nucleic acid molecule in a cell. The Examiners acknowledged Applicants' representatives' remarks and stated that their arguments would be carefully considered. Ms. Polizzi and Ms. Jacobson discussed the Examiner's suggestion as to how to amend claim 6 to obviate the basis of rejection of the claims under 35 USC 112, first paragraph as pertaining to subject matter not adequately described to enable the skilled artisan to make and/or use the claimed invention. Ms. Polizzi expressed concern that one of the proposed amendments would raise new issues under 35 USC 101; although the Examiners disagreed, the Examiners pointed out that more than one suggested amendment was set forth in the previous Office Action, and suggested that Applicants might prefer one of these others. With regard to the rejection of claims 6-19, 38, 41, 44, 45, 57-63, 66, 70, and 72-80 under 35 USC 112, first paragraph as containing subject matter that was not described in the specification to meet the written description inquiry, Ms. Polizzi and Ms. Jacobson proposed that the amendment of the claims to recite the limitation "isolated" should obviate the grounds of rejection. The Examiners disagreed, since the claims would still encompass subject matter not adequately described to meet the written description inquiry, but nonetheless agreed to carefully consider Applicants' arguments. Ms. Polizzi and Ms. Jacobson indicated Applicants' willingness to delete the phrase "or progeny thereof" in claim 6 to overcome the additional rejection of the claims under 35 USC 112, first paragraph as containing subject matter not adequately described in the specification to meet the requirements of the statute. Ms. Polizzi and Ms. Jacobson indicated Applicants' willingness and ability to submit a declaration under 37 CFR 1.132 to obviate these grounds of rejection. Finally, Ms. Polizzi and Ms. Jacobson requested clarification of the obviousness-type double patenting rejection, specifically inquiring why it might be viewed as necessary that such a rejection be made. The Examiners explained that while the doctrine was established to prevent unjustified or improper timewise extension of patent rights, the doctrine was also established to prevent possible harassment by multiple assignees. In conclusion, Ms. Polizzi and Ms. Jacobson thanked the Examiners for their cooperation and assistance, and the Examiners thanked Applicants' representatives for their time.